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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/737,310	12/16/2003	Yoshitaka Mishima	121027-0202	5968

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BUTZEL LONG
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ANN ARBOR, MI 48104

EXAMINER

BOGART, MICHAEL G

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/737,310	MISHIMA, YOSHITAKA	
	Examiner	Art Unit	
	Michael G. Bogart	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/016,051.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>16 December 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested:

--Disposable Diaper with Skin Contactable Sheets Spaced Above Skin-Contactable Surface--.

Claims 5 is objected to because of the following informalities:

Claim 5 recites the limitation "said skin-contactable sheets" in line 10. There is insufficient antecedent basis for this limitation in the claim. The preceding description of this limitation is "skin-contacting sheets" in line 9. Both of these descriptions are used interchangeably throughout the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5-7 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in

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the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 5 includes the limitation “a liquid absorbent panel attached to base sheet and lying on said skin contactable surface”. There is no support in the specification or the claims for this limitation. They show the absorbent panel (4) as lying between base sheet (3) and skin-contactable surface (1a). Also, give the context of the skin-contactable surface in the rest of the claim and the specification, it functions as the skin-contactable surface of the absorbent panel itself, and thus contradicts this limitation, as the absorbent panel cannot not lie upon its own skin-facing surface.

Claims 6 and 7 are rejected as being dependent upon non-enabled claim 5.

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-7 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As described above, claim 5 includes the limitation “a liquid absorbent panel attached to base sheet and lying on said skin contactable surface”. Given the usage of “skin-contactable surface” in subsequent portions of the claim and in the specification, this relationship between the absorbent panel and its own skin-contactable surface or top sheet is not possible. The absorbent panel cannot simultaneously lie upon its own top surface while that top surface, together with the skin-contactable sheets cover the absorbent panel.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5 and 6 are rejected under 35 U.S.C. § 102(e) as being anticipated by Otusbo (US 6,497,693 B1).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

It is noted that for the purposes of examination against the prior art, the limitation “a liquid absorbent panel attached to base sheet and lying on said skin contactable surface” is given minimal patentable weight because, as described above, it contradicts other aspects of the claims.

Regarding claim 1, Otusbo teaches a disposable undergarment (1) comprising:

a skin-contactable surface (2);

a non skin-contactable surface (outer surface of (3)) opposed to said skin-contactable surface (2);

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a liquid-impervious base sheet (3) contoured by longitudinally opposite end portions (22) extending in a transverse direction and transversely opposite side edge portions (6a) extending in a longitudinal direction (Y);

a liquid-absorbent panel (4) attached to said base sheet (3); and

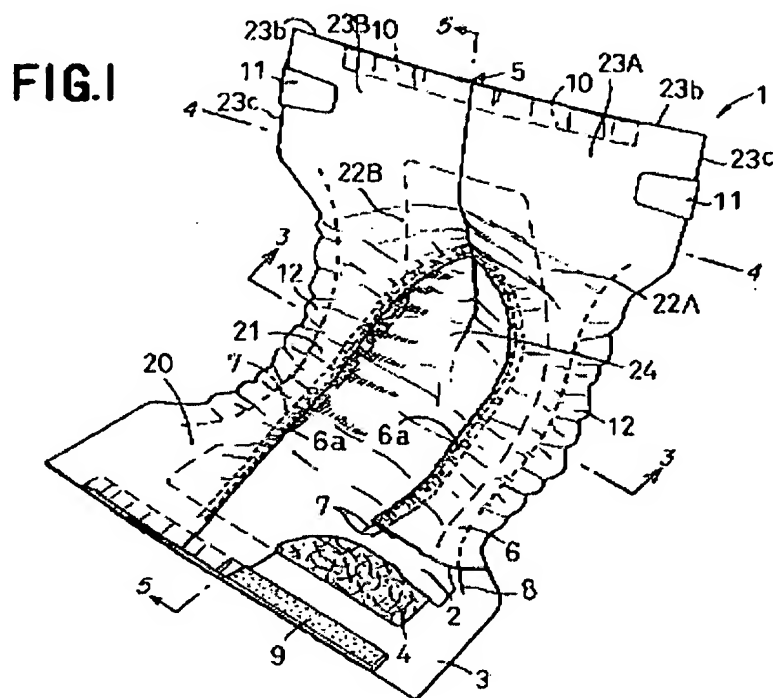
skin-contacting sheets (6) attached under tension in said longitudinal direction (Y) to said skin-contactable surface (2) of said undergarment (1) so as to cover said liquid-absorbent panel (4), said skin-contactable sheets (6) being stretchable in said longitudinal direction (Y) and substantially liquid-impervious, said skin-contactable sheets (6) having fixed surface areas (6c) secured to said longitudinally opposite end portions (22) and free surface areas extending (6a) between said fixed surface areas (6c), which free surface areas (6a) are not fixed to said undergarment (1) so as to be spaced upward from said liquid-absorbent panel (4) as said undergarment (1) curves in said longitudinal direction (Y) with its skin-contactable surface (2) inside, said skin-contactable sheets (6) are being made of a non-stretchable fibrous nonwoven fabric and elastically stretchable members (7) are being attached under tension in said longitudinal direction (Y) to said non-stretchable fibrous fabric so that said skin-contactable sheets (6) may have a stretchability in said longitudinal direction (Y)(figure 1).

Regarding the limitation concerning the non-stretchability of the fabric used in the skin-contactable sheets (6), the stretchable members (7) are added to the fabric to make the sheet (6) stretchable.

Regarding claim 6 Otusbo teaches that said skin-contactable sheets (6) comprise a pair of belt-shaped strips spaced apart from and opposed to each other in said transverse direction and respectively extending along said transversely opposite side edge portions of said undergarment

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(1) in said longitudinal direction so that the skin-contactable surface (2) inclusive of said liquid-absorbent panel (4) is partially exposed between the skin-contactable sheets (6).



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Larry Schwartz may be reached at phone number (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

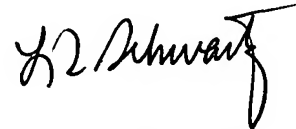
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart
22 June 2005



Larry I. Schwartz
Supervisory Patent Examiner
Group 3700